

REMARKS

The Official Action of March 5, 2010, and the references cited therein have been carefully considered. The Applicant respectfully requests reconsideration of the application in view of the following remarks.

Claims 30-48 have been canceled without prejudice. New Claims 49-68 have been added to be directed to the elected invention (Group II; compounds and pharmaceutical compositions of Formula I, having a cyclohexa[c]pyridine core wherein X is carbon and n is 0; e.g., tetrahydroquinolines). Support for new Claims 49-66 is found e.g., in the specification at page 2, line 32 to page 16, line 2, and the claims of the application as filed.

Claims 49-68 are pending in the application.

I. Rejection of Claims 30B-44 and 47 under 35 U.S.C. § 112, Second paragraph

Claims 30B-44 and 47 stand rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

The Examiner was concerned regarding the claim numbering and dependencies. As requested by the Examiner, Applicants have corrected the claim numbering and dependency issues per this amendment.

Accordingly, Applicants respectfully submit that the rejection of Claims 30B-44 and 47 under 35 U.S.C. § 112, second paragraph, for indefiniteness is untenable and should be withdrawn.

II. Rejection of Claims 30A, 30B-44 and 47 under 35 U.S.C. § 112, First Paragraph

Claims 30A, 30B-44 and 47 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement. Applicants respectfully traverse this rejection and submit that, in view of the specification and the state of the art, one of ordinary skill in the art could practice the claimed invention without undue experimentation.

The Examiner indicated that the specification was enabling for certain compounds as defined by the generic formula, was not enabling for other compounds within the broader scope of the generic formula.

Applicants respectfully submit that one of ordinary skill in the art would be able to prepare and employ a claimed nociceptin receptor antagonist for treating the subject indications without undue experimentation.

Nevertheless, in the interest of compact prosecution, the Applicants have amended the generic formula as requested by the Examiner.

Accordingly, the rejection of Claims 30A, 30B-44 and 47 under 35 U.S.C. § 112, first paragraph, for lack of enablement is untenable and should be withdrawn.

III. Allowable Subject Matter

Applicants gratefully acknowledge that Claims 45-46 are objected to for containing non-elected subject matter, but would be allowable if the non-elected material were removed. Applicants have amended the claims accordingly to be directed to the elected invention (i.e. Group II). This amendment is being made without prejudice to the filing of a divisional application directed to the non-elected subject matter. In accordance with the third sentence of 35 U.S.C. § 121, a patent issuing from the instant application should not be a reference against any divisional application filed before the issuance of such patent.

Serial No.: 10/590,585
Case No.: BY0038
Page 9

Applicants respectfully contend that the application is allowable and a favorable response from the Examiner is earnestly solicited.

Respectfully submitted,

By /J. Eric Thies, Reg.# 35382/
J. Eric Thies
Reg. No. 35,382
Attorney for Applicant

MERCK
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-3904

Date: June 7, 2010